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GOODWIN PROCTER LLP 901 NEW YORK AVENUE, N.W. WASHINGTON, DC 20001			EXAMINER CARTER, CANDICE D	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/830,114	Applicant(s) BRENNER ET AL.	
	Examiner CANDICE D. CARTER	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/19/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is a First Action Non-Final on the merits. Claims 1-33, as originally filed, are currently pending and have been considered below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1, 16, and 31-33 recite the limitation "carrier". Examiner contends that the recited carrier wave is a form of energy, per se, and thus currently not believed to fall within a statutory category. As such, the claimed methods, systems, and computer readable medium are not limited to embodiments which fall within a statutory category of invention and would enable the functionality of the instructions to be realized.

Claim 32 is directed to a computer readable medium consisting essentially of programming code. Programming code is not a process, machine, manufacture, or composition of matter and is, thus, not considered to fall within one of the statutory categories.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 16, and 31-33 recite the limitation “delivering the plurality of data and the carrier to the one or more presentation channels”. Examiner is unsure what Applicant means by the limitation in these claims. For examination purposes, Examiner interprets this limitation to mean “delivering the plurality of data and the carrier through the one or more presentation channels”. Appropriate clarification is requested.

Claims 3 and 18 recite the limitation “financial products”. Examiner is unsure what Applicant means by the limitation in these claims. It is unclear what Applicant considers to be a "financial product". Appropriate clarification is requested.

Claims 4 and 19 recite the limitation “style tags”. Examiner is unsure what Applicant means by the limitation in these claims. Appropriate clarification is requested.

Claim 6, 21, and 33 recite the limitation “media-independent format”. Examiner is unsure what Applicant means by the limitation in this claim. For examination purposes, Examiner interprets this term to mean different formats. Appropriate clarification is requested.

Claims 10 and 25 recite the limitation “lines of business”. Examiner is unsure what Applicant means by the limitation in these claims. It is unclear what type of "lines of business" Applicant is referring to in the context of this application. Appropriate clarification is requested.

Claims 14 and 29 recite the limitation “layout file for distribution”. Examiner is unsure what Applicant means by the limitation in these claims. For examination purposes, Examiner interprets this term to mean any file intended for distribution. Appropriate clarification is requested.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 15-18, and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by George et al. (2002/0095481, hereinafter George).

As per claim 16, George discloses “A system for management and delivery of content and rules, the system comprising:

at least one first database entity that manages a plurality of data” (Fig. 1 discloses a customer database managing customer information);

“at least one second database entity that manages a plurality of content, wherein the plurality of content is associated with the plurality of data based on a plurality of rules” (Fig. 1 discloses a content database and ¶ 8 discloses that the content database contains product data sets that are associated with the customers and ¶ 23 discloses associating the product data sets with the customer data using a set of business rules);

“a processor module” (Fig. 1 discloses an email content merge program that serves as a processor module);

“a delivery module” (Fig.1 discloses an email delivery server);

“and one or more presentation channels” (Fig. 1 discloses an email delivery server that serves as a presentation channel, where the electronic communication is used as a presentation channel);

“where the processor module packages the plurality of rules with the plurality of content in a carrier that is independent from the one or more presentation channels, wherein at least part of the plurality of content is integrated with at least part of the plurality of data” (¶ 19 discloses the email content merge program selecting a product data set as a function of the information contained in the customer database and business rules as disclosed in ¶ 23 so that a message can be constructed, where it is inherent that a carrier is used to package and transport information);

“the delivery module delivers the plurality of data and the carrier to the one or more presentation channels” (¶ 19 discloses constructing and sending a communications message such as an email);

“and the one or more presentation channels integrate the plurality of data with the plurality of content based on the plurality of rules, and distribute the integrated data and content” (¶ 19 discloses constructing and sending a communications message such as an email and ¶ 23 discloses associating the product data sets with the customer data using a set of business rules).

Claims 1 31, and 32 recite equivalent limitations to claim 16 and are, therefore, rejected using the same art and rationale as set forth above.

As per claim 2, George discloses “the plurality of data is associated with a plurality of products and a plurality of clients” (¶ 19 discloses a customer profile/behavioral data stored in a database that is associated with product data sets from a content database).

Claim 17 recites equivalent limitations to claim 2 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 3, George discloses “the plurality of data and the plurality of content is associated with financial products” (¶ 19 discloses the content database managing product data sets).

Examiner considers financial products to be nonfunctional descriptive material as recited. The type of product that the content is associated with does not change the function of the claimed invention. Examiner contends that the content database of George is fully capable of managing any type of product data.

Claim 18 recites equivalent limitations to claim 3 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 15, George discloses “the one or more presentation channels comprises an electronic communication” (Fig. 1 and ¶ 19 discloses an email message)

Claim 30 recites equivalent limitations to claim 15 and is, therefore, rejected using the same art and rationale as set forth above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 9, 10, 12, 14, 19, 24, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over George in view of Quatse et al. (2005/0010472, hereinafter Quatse).

As per claim 4, George discloses all of the elements of the claimed invention but fails to explicitly disclose "the carrier comprises a plurality of style tags, wherein the plurality of style tags are associated with the plurality of content based on a plurality of rules"

Quatse discloses high-precision customer-based targeting having style tags that are associated with the plurality of content based on the plurality of rules (§ 48 discloses customers being marked according to rules, methods, or algorithms to identify the appropriate market segment to which they belong in order to determine which promotional offers to send them).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of George to include the style tags as taught by Quatse in order to predict the probability of a customer accepting a promotional offer.

Claim 19 recites equivalent limitations to claim 4 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 9, George discloses all of the elements of the claimed invention but fails to explicitly disclose “the integration of plurality of data with the plurality of content is further based on the specific needs of the one or more presentation channels”.

Quatse discloses high-precision customer-based targeting integrating the data based on the specific needs of the one or more presentation channels (§ 36 discloses promotional offers are presented by distributing offers through the channels in formats particular to the channel).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of George to include the integration of data based on the needs of the presentation channel as taught by Quatse in order to facilitate the use of the different presentation channels.

Claim 24 recites equivalent limitations to claim 9 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 10, George discloses all of the elements of the claimed invention but fails to explicitly disclose “sharing the plurality of data and the plurality of content among a plurality of business lines”.

Quatse discloses high-precision customer-based targeting sharing the plurality of data and the plurality of content among the plurality of business lines (§ 48 discloses segmenting customers into market segments, where customer and product data are shared among market segments and where examiner construes market segments to be business lines).

Claim 25 recites equivalent limitations to claim 10 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 12, George discloses all of the elements of the claimed invention but fails to explicitly disclose “comprising previewing at least one combination of the plurality of data and the plurality of content for legal compliance”.

Quatse discloses laws penalizing a telemarketer who calls a telephone that is registered on a “do not call” list (§ 12).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of George to include the penalty for calling those telephone numbers that are on the “do not call list” in order to deter telemarketing companies from violating the list.

The George and Quatse combination fails to explicitly disclose “previewing the plurality of data and content for legal compliance.”

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of the George and Quatse combination to include previewing content for legal compliance because it is old and well known to monitor business operations to ensure that all practices comply with the law.

Claim 27 recites equivalent limitations to claim 12 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 14, George discloses all of the elements of the claimed invention but fails to explicitly disclose “automatically generating at least one layout file for distribution”.

Quatse discloses high-precision customer-based targeting generating at least one layout file for distribution (§ 63 discloses offer distribution lists).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of George to include the distribution list as taught by Quatse in order to distribute the promotional offers to customers.

Claim 29 recites equivalent limitations to claim 14 and is, therefore, rejected using the same art and rationale as set forth above.

10. Claims 6-8, 11, 13, 21-23, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over George.

As per claim 6, George discloses all of the elements of the claimed invention but fails to explicitly disclose “the plurality of content is stored in at least one media-independent format”.

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of George to include the content stored in media-independent format because it is old and well known to store information in different formats that may be compatible with different systems.

Claim 21 recites equivalent limitations to claim 6 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 7, George discloses implementing the invention using a plurality of programming languages (¶ 15).

George, however, fails to explicitly disclose the plurality of content is packaged based on an extensible markup language.

It would have been obvious to one of ordinary skill at the time the invention was made to modify the method and system for customizing electronic communications of George to include the extensible markup language because XML is a commonly used programming language.

Claim 22 recites equivalent limitations to claim 7 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 8, George discloses implementing the invention using a plurality of programming languages (¶ 15).

George, however, fails to explicitly disclose the plurality of content is packaged based on an XSL transformations language.

It would have been obvious to one of ordinary skill at the time the invention was made to modify the method and system for customizing electronic communications of George to include the XSL transformations language because XSLT is a commonly used programming language.

Claim 23 recites equivalent limitations to claim 8 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 11, George discloses all of the elements of the claimed invention but fails to explicitly disclose “editing the plurality of content and the plurality of business rules via a user interface”.

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of George to include the editing of content and business rules via a user interface because it is old and well known to edit information that is used for business operations and to edit information using an interface such as a keyboard in order to ensure that the information is accurate and up to date.

Claim 26 recites equivalent limitations to claim 11 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 13, George discloses all of the elements of the claimed invention but fails to explicitly disclose “auditing the integrated data and content prior to the step of distributing”.

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of George to include auditing the data before distributing the content because it is old and well known to review documents or content in order to make sure that they are in compliance with company policy.

Claim 28 recites equivalent limitations to claim 13 and is, therefore, rejected using the same art and rationale as set forth above.

11. Claims 5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over George in view of LeMole et al. (6,009,410, hereinafter LeMole).

As per claim 5, George discloses all of the elements of the claimed invention but fails to explicitly disclose "the plurality of content comprises a graphic element".

LeMole discloses a method and system for presenting customized advertising to a user on the World Wide Web presenting graphic element content (abstract discloses 3D images, animation, and video).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system of customizing electronic communications of George to include the graphic element content as taught by LeMole in order to sufficiently present the content to the user in a format that is easily understood.

Claim 20 recites equivalent limitations to claim 5 and is, therefore, rejected using the same art and rationale as set forth above.

12. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over George in view of LeMole and further in view of Quatse.

As per claim 33 George discloses "A method for management and delivery of content and rules, the method comprising:

managing, for an organization, a plurality of data and a plurality of content in separate database entities, wherein the plurality of data are associated with a plurality of products and a plurality of clients, and the plurality of content is associated with the plurality of data based on a plurality of rules" (§ 8 discloses a customer database and a

content database and ¶ 23 discloses associating content and customer data based on business rules);

“packaging the plurality of rules with the plurality of content in a carrier that is independent from one or more presentation channels, wherein at least part of the plurality of content is integrated with at least part of the plurality of data” (¶ 19 discloses an email content merge program, merging the content and customer data together, where it is inherent that the information is transported using a carrier),

“delivering the plurality of data and the carrier to the one or more presentation channels, wherein the one or more presentation channels comprise at least one of an Internet website, a printed communication, an electronic communication, a printed advertisement, a broadcast advertisement, a telemarketing script, an interactive voice response unit message, an automatic teller machine (ATM) message, and a display-board message” (¶ 19 discloses constructing and sending a communications message such as an email);

“integrating, at the one or more presentation channels, the plurality of data with the plurality of content based on the plurality of rules and distributing the integrated data and content through the one or more presentation channels” (¶ 19 discloses an email content merge program, merging the content and customer data together and emailing the content to the customer).

George, however, fails to explicitly disclose “the plurality of content is stored in at least one media-independent format and comprises at least one of a discrete text element, a compiled text element and a graphic element, the plurality of content is

packaged based on an extensible markup language (XML), and the plurality of rules are packaged based on an XSL transformations (XSLT) language; and the content is packaged based on the specific needs of the one or more presentation channels”;

LeMole discloses a method and system for presenting customized advertising to a user on the World Wide Web presenting graphic element content (abstract discloses 3D images, animation, and video).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system of customizing electronic communications of George to include the graphic element content as taught by LeMole in order to sufficiently present the content to the user in a format that is easily understood.

The George and LeMole combination fails to explicitly disclose that the content is packaged based on the specific needs of the one or more presentation channels.

Quatse discloses high-precision customer-based targeting integrating the data based on the specific needs of the one or more presentation channels (§ 36 discloses promotional offers are presented by distributing offers through the channels in formats particular to the channel).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of the George and LeMole combination to include the integration of data based on the needs of the presentation channel as taught by Quatse in order to facilitate the use of the different presentation channels.

The George, LeMole and Quatse combination fails to explicitly disclose “the plurality of content is stored in at least one media-independent format, the plurality of content is packaged based on an extensible markup language (XML), and the pluralities of rules are packaged based on an XSL transformations (XSLT) language”.

It would have been obvious to one of ordinary skill at the time the invention was made to modify the method and system for customizing electronic communications of George to include media independent format, the extensible markup language and XSL transformations language because it is old and well known to store information in different formats that may be compatible with different systems and because XML and XSLT are commonly used programming languages.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Damico et al. (5,819,285) discloses an apparatus for capturing, storing and processing co-marketing information associated with a user of an on-line computer service. Deaton et al (5,675,662) discloses a method and system for building a database for user with selective marketing in response to customer shopping histories. Hedgecock et al. (6,182,060) discloses a method and apparatus for storing retrieving and processing multi-dimensional customer-oriented data sets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CANDICE D. CARTER whose telephone number is (571) 270-5105. The examiner can normally be reached on Monday thru Thursday 7:30am- 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. D. C./
Examiner, Art Unit 3629

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